

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert Boock et al.

Application No.: 10/661,460

Filed: September 11, 2003

Entitled: TISSUE EXTRACTION AND
MACERATION DEVICE

Docket No.: 22956-223

Group Art Unit: 3736

Examiner: J. G. Hoekstra

Certificate of Mailing (37 C.F.R. 1.8(a))

I hereby certify that this correspondence is being electronically filed via EFS-Web to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

February 6, 2008

Date of Signature and Mail Deposit

By:



Lisa Adams, Reg. No: 44,238
Attorney for Applicant(s)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This communication is in response to the Office Action dated January 15, 2008. Claims 1-16, 18-25, 31, and 32 are currently pending.

The Examiner requires restriction of the above-referenced application to one species in each of the following sets:

Set 1:

- A: Figure 3A
- B: Figure 3B
- C: Figure 3C
- D: Figure 3D

Set 2:

- AA: Figure 4A
- BB: Figure 4B
- CC: Figure 4C
- DD: Figure 4D
- EE: Figure 4E
- FF: Figure 4F

Set 3:

AAA: "translating embodiment" paragraphs 30-32

BBB: "rotating embodiment" claim 32

CCC: "translating and rotating embodiment" paragraph 34

At the outset, Applicants traverse the restriction requirement.

First, there would be no serious burden on the Examiner if restriction is not required. In particular, the Examiner has searched all tissue harvesting tips of Set 1, all cutting members of Set 2, and all embodiments of Set 3 for previous Office Actions. It would present no additional burden to continue prosecution without a restriction. Applicants do not understand why the Examiner is now requiring restriction of the claims after such lengthy prosecution.

Second, with respect to Set 3, Applicants disagree with the Examiner's characterization of the embodiments. All embodiments in the present application both rotate *and* translate. In particular, paragraphs [0030]-[0032] (Species AAA) of the specification describe the structure of the device 10 that allows the shaft 14 to translate, while paragraph [0034] (Species CCC) of the specification describes the rotating aspect of the same device 10. In addition, paragraph [0030] of the specification clearly states that the shaft 14 is *rotatably* disposed in the outer tube 12. The same paragraph [0030] then goes on to state that the shaft 14 is movable between a first proximal position and a second distal position, indicating translational motion. Accordingly, separate "translating" and "rotating" embodiments do not exist in the present application, and thus species AAA and BBB are not proper. Reconsideration and withdrawal of the restriction requirement is therefore respectfully requested.

Since Applicants are required to make an election, Applicants elect, with traverse, Species D, Species EE, and Species CCC. Claims 1-11, 14-16, 18-25, and 31 are generic to all species in Set 1, and claims 13 and 32 read on elected species D. Accordingly, claim 12 is withdrawn from consideration. All pending claims are generic to all species in Set 2, and therefore no further claims are withdrawn from consideration. All pending claims are also generic to all species in Set 3, or all claims at least read on elected species CCC. Thus, no further claims are withdrawn from consideration.

Appl. No.: 10/661,460
Filing Date: September 11, 2003
Group Art Unit: 3736
Examiner: J. Hoekstra
Atty. Docket No.: 22956-223

Accordingly, claims 1-11, 13-16, 18-25, 31, and 32 are currently pending in this application, and claim 12 is withdrawn from consideration. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

Date: February 6, 2008

Nutter McClennen & Fish LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02210
Tel: (617)439-2550
Fax: (617)310-9550



Lisa Adams, Reg. No. 44,238
Attorney for Applicant(s)